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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,904	11/27/2001	A. Kenneth Jordan	HAMI B-2045	7364

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WILLIAM R. GUSTAVSON
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DALLAS, TX 75243

EXAMINER

POE, MICHAEL I

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No.	Applicant(s)	
	09/994,904	JORDAN ET AL.	
	Examiner	Art Unit	
	Michael I Poe	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>20020304</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to an apparatus for passing strand through apertures in members in a mold, classified in class 425, subclass 111.
 - II. Claims 13-18, drawn to a method of feeding strand through apertures in members in a mold, classified in class 264, subclass 228.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group II and Group I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another materially different process wherein the rod, collar and end of the strand are pulled through the apertures with the strand rather than pushed through the apertures as currently claimed.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with applicant's attorney William Gustavson on January 16, 2004, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 1-12 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-12 of copending Application No. 10/302,750. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,719,982 (Tindal) in view of U.S. Patent No. 3,785,617 (Friedrich).

Claims 1-5, 7 and 10-12

Tindal teaches an apparatus for threading (passing) a tendon (strand) through a sheath (apertures) including a spud 51, mounted on the end of the tendon to facilitate its passage through the sheath, comprising a casing 52 (a second portion forming a collar) fitting snugly over the end of the cable (the collar defining a receptacle to receive an end of the strand; the collar defines an interior cylindrical surface forming the receptacle for the strand and a passage opening through a forward end thereof) and

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a nose-piece 54 (a first portion forming a rod having a first end and a second end) having a tube 56 centrally thereof secured to a base 53 of the casing 52 (at the second end of the rod) by threads 57 on the tube 56 which engage a threaded recess in the base 53 of the casing 52 (the collar is mounted to the rod permitting rotation of the collar relative to the rod about an elongate axis of the collar; a bolt mounting the collar to the rod while permitting the collar to rotate relative to the rod about the elongate axis of the collar; a bolt, the bolt having a head received in the collar, the bolt threaded into the rod to permit limited movement of the collar relative to the bolt; the rod and the collar are integral) (column 2, lines 63 - column 3, line 7). As illustrated in Figure 2, the casing 52 and the nose-piece 54 have diameters sized to pass through the apertures. As illustrated in Figure 7, the casing 52 has a cylindrical outer surface (the collar has a receptacle portion having a cylindrical exterior surface) and the nose-piece 54 has a tapered exterior surface (a forward portion having a tapered exterior surface; the first end of the rod is tapered). Note that, as currently claimed, the capability of limited movement of the collar relative to the rod is readable on the ability to screw and unscrew the collar from the rod and the capability of limited movement is not required to allow limited angular and parallel misalignment of the collar with respect to the rod except in claim 6. Tindal further teaches that the apparatus comprises a jacking mechanism including a suitable support frame 21 mounted on a base plate 23 connected to a top support 26 via mounting bolts 24, a platform 27 (a strand feeder rack) disposed between the base plate 23 and the top support 26 that is movable on bearings 28 along the support bolts 24 (a track) toward and away from the top support 26 by means of hydraulic raising and lowering jacks 29 (the strand feeder rack slidable on the track from a position adjacent a strand and a second position adjacent the mold; the strand feeder rack moving the end of the strand to the second position adjacent the mold when the strand feeder rack moves to the second position), and clamps 31 mounted upon the platform 27 and the base plate 23 for gripping the cable (the strand feeder rack having at least one notch to receive the end of the strand) (column 2, lines 24-54).

Tindal does not specifically teach that the apparatus could be used for threading a tendon into a mold to allow prestressing of the tendons. However, Friedrich teach a method and an apparatus for inserting tendons into sheathing placed in form work prior to concrete pour including gripping a tendon with a clamp device operated by a motor and actuating the clamping device towards the sheathing in which the tendon is to be inserted to thus move, by pushing, the tendon along its longitudinal dimension to

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insert it axially into the sheathing in the form work (an apparatus for passing strand through apertures in members in a mold) (column 1, lines 7-17; column 1, line 58 - column 2, line 9). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made and one of ordinary skill would have been motivated to use the apparatus of Tindal to insert tendons into molds as taught by Friedrich to provide an apparatus capable of inserting tendons into molds regardless of the size or weight of the tendon and the curvature of its path during insertion (see specifically column 1, lines 28-37 of Friedrich).

Claims 8 and 9

The discussion of Tindal and Friedrich as applied to claim 1 above applies herein.

With regard to the length of the rod and the diameter of the receptacle, the examiner stipulates that Tindal recognized that these variables as result-effective variables. For example, Tindal indicates that the cable is relatively heavy and is made up of the order of some 170 to 200 strands of high carbon steel; therefore, it is evident that Tindal recognized that the inner diameter of the receptacle in the casing 52 must be variable to accept the change in diameter of the cable. Since the length of the rod and the diameter of the receptacle are result-effective variables as recognized by Tindal, one of ordinary skill in the art would have obviously determined the optimum length of the rod and the diameter of the receptacle through routine experimentation based on the characteristics of the cable (e.g., the number of strands, the flexibility of the cable, the material of construction of the cable, etc.).

Allowable Subject Matter

10. Claim 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 101 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

- (1) the prior art of record does not teach or suggest the claimed apparatus for passing strand through apertures in members in a mold, as a whole, especially including a first portion forming a rod and a second portion forming a collar at the second end of the rod wherein the collar is mounted to the rod to permit limited angular and parallel misalignment of the elongate axes of the rod and collar as described on page 10, 2nd paragraph of the applicant's original disclosure.

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Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 2,863,206 (Kirchner), U.S. Patent No. 3,055,073 (Gerwick, Jr.), U.S. Patent No. 3,524,228 (Kelly), U.S. Patent No. 3,827,132 (Bratchell), U.S. Patent No. 3,975,815 (Mori), U.S. Patent No. 4,095,326 (Harvey), U.S. Patent No. 4,290,991 (Thim), U.S. Patent No. 4,726,560 (Dotson), U.S. Patent No. 4,953,280 (Kitzmiller) and U.S. Patent No. 4,999,150 (Bevan) have been cited of interest to show the state of the art at the time the invention was made.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael I Poe whose telephone number is (571) 272-1207. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael Poe/mip



MICHAEL COLAIANNI
PRIMARY EXAMINER